



10205.028
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Examining Group: 2644
Story et al. : Examiner: RP Singh
Serial No.: 09/769,564 : Date: January 12, 2005
Filed: January 25, 2001 :
For: *Narrow Band Shadow Encoder*

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ELECTION

Honorable Commissioner for Patents
Alexandria, VA 22313

SIR:

In response to the Office Action dated November 17, 2004, applicants hereby elect the invention identified as "Species I", represented by claims 1-5 and 16 with traverse.

The restriction requirement is traversed because it is ill formed.

In General

The Examiner appears to mean that there are plural inventions, not plural species. It is unusual to find an election of species requirement outside chemical practice. On the other hand, a review of the MPEP was no help in finding a definition of "species." The undersigned was taught, as an Examiner, that species related to

various aspects of an invention as part of a claim. That is, a combination ABC could have species ABC₁, ABC₂, ABC₃ and so on. Typically, the situation arose in chemical applications where various materials could be substituted. This is similar to the example given in MPEP §803.02 (page 800–5) concerning Markush groups.

The point is that the species were one element of a claim, not entire claims. Entire claims that are so different in scope as to constitute different inventions are subject to “restriction”, not “election.” Blending the two related but distinct concepts does nothing to make Office Actions more intelligible. On the other hand, as noted above, the MPEP is certainly of little help.

In Particular

The Examiner is paraphrasing the preambles of the independent claims to sustain the election requirement. Applicants have not indicated that the preambles are restrictive and the recitations of the claims do not relate back to anything recited in the preambles. Thus, the alleged differences are not actually based upon the invention as claimed.

Claim 1 is a method claim. Claim 6 is an apparatus claim. The apparatus recited corresponds to the steps recited. How can these be different “species”?

Claim 1 is allegedly illustrated by FIG. 1. Claim 1 recites the step of “dividing an audio signal into a plurality of bands.” Where is this illustrated in FIG. 1? Where are the two combining steps illustrated in FIG. 1?

Claim 6 is allegedly illustrated by FIG. 2. Claim 6 recites “a plurality of band pass filters.” Where are these shown in FIG. 2? Claim 6 also recites “a plurality of delay lines, each having an input coupled to the output of a band pass filter and an output.” Where are these shown in FIG. 2? Claim 6 recites “a plurality of summation circuits.” Where are these shown in FIG. 2?

The truth is that claims 1 and 6 are illustrated by FIG. 3, not by FIG. 1 or FIG. 2. How can different species be illustrated by the same figure?

An Alternative

In the unlikely event that the Examiner changes his mind and wants to restrict among inventions, one could consider claims 1-8 and 16 as relating to modulation, claims 9-12 as relating to remote control of a telephone, and claims 13-15 as relating to demodulation. In such circumstance, applicants would elect claims 1-8 and 16 for further prosecution. The election would also be with traverse because the claims are related as inverse operations and claims 9-12 recite a particular use of the invention.

Respectfully submitted,



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